



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 020431.0750

In re Application of:

**NOEL TENORIO**

Serial No. 09/750,617

Filed: 20 DECEMBER 2000

For: **SYSTEM AND METHOD FOR  
NEGOTIATING ACCORDING TO  
IMPROVED MATCHING CRITERIA**

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Examiner:

**LALITA M. HAMILTON**

Art Unit: 3624

Confirmation No.: 6553

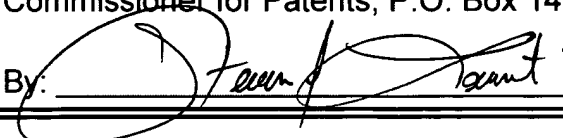
**REPLY BRIEF**

**MAIL STOP: APPEAL BRIEF - PATENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Appellant respectfully submits this Reply Brief under 37 C.F.R. § 41.41(a)(1) in response to the Examiner's Answer mailed 3 July 2006, which provides for a response period ending 5 September 2006 (since 3 September 2006 is a Sunday and 4 September 2006 is a Federal Holiday).

<b>CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)</b>
Date of Deposit: <u>9/5/06</u>
I hereby certify that this paper or fee is being deposited with the United States Postal Service as First Class Mail with sufficient postage under 37 C.F.R. §1.8(a) on the date indicated above and is addressed to Mail Stop: APPEAL BRIEF - PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.
By: <u></u>

## **REMARKS:**

The Appellant filed an Appeal Brief on 6 April 2006 explaining clearly and in detail why the final rejection of Claims 1-70 is improper and why the Board should reverse this final rejection. As explained in more detail below, the Examiner's final rejection of these claims cannot be properly maintained. Appellant respectfully requests the Board to reverse this final rejection and instruct the Examiner to issue a Notice of Allowance with respect to these claims.

### **Appellant's Claims are Allowable Over the Cited References**

Section 9 of the Examiner's Answer consists entirely of material repeated verbatim from the Final Office Action mailed 16 December 2004. Section 10 of the Examiner's Answer consists of four paragraphs.

The first paragraph consists entirely of referring the reader to previous information contained in the Interview Summaries submitted on 2 March 2006 and 27 December 2005, the second and third paragraphs consists entirely of material repeated verbatim from the Final Office Action mailed 12 August 2005, and the fourth paragraph consists of material repeated from the Office Action mailed 16 December 2004. Below, the Appellant's specifically address the second, third, and fourth paragraphs of Section 10 of the Examiner's Answer

In the second paragraph of Section 10 of the Examiner's Answer, the Examiner asserts (in reference to independent Claim 1 of the subject Application):

*May discloses a database operable to store profiles, where each profile specifies values for one or more parameters being negotiated (user may enters profiles which are then stored when requesting an "Request for Price" quote; the RFP specifies the values of one or more parameters being negotiated-p. 30, 374-377); a matching server operable to compute a distance between values in an offer and values in the profile of the second party (the system is capable of computing a distance between the values in an offer and values in the profile of a second party when conducting an RFP to determine the best match); and causing the offer to be accepted if the distance is acceptably small and modifying values of the offer if the distance*

is not acceptably small (RFP is accepted if it meets the requirements entered into the system or comes very close to meeting the requirements entered into the system; ***[in May] if the RFP is not acceptable-distance not acceptably small, then a response to the bid changing parameters-counteroffer-may be submitted***). (3 July 2006 Examiner's Answer, Page 9). (Emphasis Added).

The Appellant respectfully disagrees with the Examiner.

In fact, the above cited portion of the Examiner's answer is merely repeated verbatim from the Final Office Action mailed 12 August 2005. In addition, during a telephone interview conducted on 1 December 2005, Appellant requested clarification with respect to the above emphasized Examiner's assertion, pointing out that in *May* the system allows a user to change values. The Examiner confirmed that rejection was based on the capability of the *May* system to allow a user to change values. Given that the Examiner has conceded that *May* only allows for a user to change values, whereas independent Claim 1 requires that the server ***automatically*** changes values, Appellant is unclear as to why the present rejection is being maintained. Since *May* fails to disclose all of the limitation of independent Claim 1, as acknowledged by the Examiner, *May* cannot anticipate independent Claim 1. Therefore, the Appellant respectfully submits that the rejection of independent Claim 1 is improper under 35 U.S.C. § 102 and the Board should reverse this rejection.

In addition, the Examiner further asserts that the "Examiner is interpreting *May* as reading onto the invention ***substantially as claimed***." (3 July 2006 Examiner's Answer, Page 9). (Emphasis Added). However, it is respectfully pointed out that "***substantially as claimed***" is not the correct standard for establishing a *prima facie* case of anticipation. A claim is anticipated by a prior art reference only if the reference discloses or inherently describes ***every detail*** of the claim. According to the MPEP, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (MPEP § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Also according to the MPEP, "[T]he identical invention must be shown in as complete detail as is contained in the ... claim." (*Id.*, citing *Richardson v. Suzuki Motor*

Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Therefore, the Appellant respectfully submits that the rejection of independent Claim 1 is improper under 35 U.S.C. § 102 and the Board should reverse this rejection.

In the third paragraph of Section 10 of the Examiner's Answer, the Examiner asserts (in reference to dependent Claim 5 of the subject Application):

*May* is silent with regard to formulas that may be used to calculate distance in the auction system. *Li* teaches an auction management system in which various formulas are used to calculate constraints (Examiner is interpreting as being used to calculate a distance between values in an offer and values in the profile of a second party). The formulas taught by *Li* are not limited, and the system may be used to input any formula used to calculate constraints/distance. The Examiner has found motivation to combine in the fact that both *May* and *Li* disclose and suggest auction management systems in which parameters are used in negotiation; however, *May* is silent as to formulas that may be used in determining which offers to accept and reject. (3 July 2006 Examiner's Answer, Page 10). (Emphasis Added).

The Appellant respectfully disagrees with the Examiner.

In fact, the above cited portion of the Examiner's answer is merely repeated verbatim from the Final Office Action mailed 12 August 2005. The Appellant respectfully submits that the proposed combination of *May* and *Li* fails to disclose, teach, or suggest the specific way in which distance is calculated according to Claim 5, where "**distance**" is **a distance between values in an offer from a first party and values in a profile of a second party**. The Examiner concedes that *May* is silent in this regard, instead relying on alleged teaching of *Li*. With respect to *Li*, the Examiner's Answer indicates that *Li* discloses formulas to calculate constraints, which the Examiner interprets as being used to calculate a distance between values in an offer and in a profile. However, the Appellant respectfully submits that it is unclear how the Examiner arrived at this interpretation. In addition, it is respectfully pointed out that the standards set forth by the MPEP require that all of the limitations of the claim must be taught or suggested by the prior art in order to establish a *prima facie* case of obviousness:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP § 2143.03).

Therefore, the mere fact that *Li* teaches the general use of formulas is insufficient for establishing a *prima facie* case of obviousness, since *Li* (and *May*) fail to disclose, teach, or suggest all of the limitations of Claim 5. Therefore, the Appellant respectfully submits that the rejection of Claim 5 is improper under 35 U.S.C. § 103 and the Board should reverse this rejection.

In the fourth paragraph of Section 10 of the Examiner's Answer, the Examiner asserts that *May* is valid prior art. The Appellant respectfully disagrees with the Examiner. The Appellant respectfully submits that the subject Application was filed 20 December 2000. However, *May* was not filed until 11 June 2001. Therefore, because the filing date of *May* is after the filing date of the present application, *May* is not properly citable as prior art under 35 U.S.C. § 102(e). It is noted, however, that *May* claims priority to two provisional applications, filed 14 June 2000 and 9 June 2000, respectively. For this reason, it was requested that a showing be made under MPEP 2136.03 that "the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph."

However, the Examiner declined to provide such a showing, instead making an allegation that the "Applicant acquiesced". (15 November 2005 Advisory Action, Page 2). During a telephone conversation on 17 November 2005, and again during the telephone interview on 1 December 2005, Applicant requested that the Examiner explain the basis of the alleged allegation. However, both times the Examiner was unable to cite a rule or other authority to support the Examiner's allegation. The Applicant respectfully submits that this allegation is baseless and contrary to fact.

Therefore, the Appellant respectfully submits that *May* is not valid prior art and the Board should reverse the rejection of Appellant's claims over *May*. However, in the event that *May* continues to be relied upon for rejecting claims of the subject Application, the

Appellant respectfully requests the Board to instruct the Examiner to show under MPEP 2136.03 that "the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph."

For at least the reasons set forth herein, the Appellant's claims are patentable over the cited references. The Appellant respectfully submits that the rejection of Appellant's claims is improper and the Board should reverse this rejection.

**CONCLUSION:**

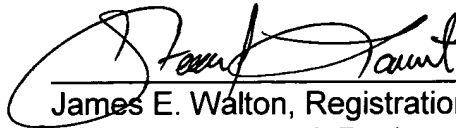
The Appellant has demonstrated that the present invention, as claimed, is clearly patentable over the prior art cited by the Examiner. Therefore, the Appellant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

Although the Appellant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

9/5/06  
Date



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**ATTORNEYS AND AGENTS FOR APPELLANT**